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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/963,720	11/04/1997	MARKO MASCEK	10191/538	1442
26646	7590	07/28/2004	EXAMINER	
KENYON & KENYON ONE BROADWAY NEW YORK, NY 10004			LOUIS JACQUES, JACQUES H	
			ART UNIT	PAPER NUMBER
			3661	

DATE MAILED: 07/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

08/963,720

**Applicant(s)**

MASCHEK, ETAL

**Examiner**

Jacques H Louis-Jacques

**Art Unit**

3661



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 16 June 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Continued Examination Under 37 CFR 1.114*

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on June 16, 2004 has been entered.

A rejection is set forth below.

### *Claim Rejections - 35 USC § 112*

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1-6 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The specification does not disclose the nature of the input [of the transfer (transmission) function] to permit calculation of the transfer function and, thus, the claims are not enabled. For example, one would need to know if the input was a step function or a pulse or some other form of input and, for example, if the input was a pulse, one would need to know things like the shape (impulse, triangle, haversine, etc.), amplitude, duration, phase, etc., none of which are disclosed. In addition, the reading of the

disclosure of the present application indicates the graph of Figure 2 is the result (output) of the transmission (transfer) function, therefore the specification fails teach how such graph is obtained. In order word what the input from which such graph is generated?

*Response to Arguments*

4. Applicant's arguments filed June 16, 2004 along with the request for continued prosecution examination (RCE) have been entered and fully and carefully considered by the examination, but they are not persuasive.

The issue in this case remains whether the specification provides adequate support for the claimed limitations.

The objection of the specification, as failing to comply with the enablement requirement because the claims contain subject matter which are not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention, is based on the last sentence of the page 3 of the specification. In particular, the specification describes, "In the next process step 4, each signal segment is simulated by a transmission function in the z plane." See the present application's specification at page 3, lines 31-32.

In the remarks filed (after final) on April 7, 2004, Applicant's stated, "When a sentence states that a segment is simulated by a transmission function, it is worded in the passive voice, which means that the subject, in this case "segment" is being acted upon by the verb "simulated." The agent or cause of this simulation performed on the segment is the transmission function. As a matter of simple logic, before the transmission function can simulate the segment, the segment

must first be provided or supplied to the transmission function, which is merely another way of saying that the segments are input to the transmission function. Therefore, they are inputs.” Emphasis added. Applicant is correct, except for the underlined portion and the characterization of the verb “simulate”.

In the remarks accompanied the RCE, Applicant cited some case laws to support his position. In particular, Applicant stated “Thus, the enablement test is “whether one reasonably skilled in the art could make or use the invention from the disclosures in the patent coupled with information known in the art without undue experimentation.” (See *id.* (citing *United States v. Teletronics. Inc.*, 857 F.2d 778, 785, 8 U.S.P.Q.2d 1217, 1223 (Fed. Cir. 1988))).” Furthermore, in paragraph bridging pages 3 and 4 of the response, Applicant’s referred to three factors that must be considered in determining whether a specification satisfies the enablement requirements. On page 4 of the response, however, applicant added that “In this regard, the Federal Circuit has also stated that it is “improper to conclude that a disclosure is not enabling based on an analysis of only one of the above factors,” and that the examiner’s analysis must therefore “consider all the evidence related to each of these factors” so that any nonenablement conclusion “must be based on the evidence as a whole.” (See M.P.E.P. 2164.01).”

In concluding that the specification fails to comply with the enablement requirement, the examiner has considered all the three factors mentioned above by Applicant and the evidence as a whole.

Let’s analyze the “enablement” problem at issue.

The specification, on page 3, describes, “each signal segment is simulated by a transmission function in the z plane.” Emphasis added.

The first question is “what is ‘simulation’?” Simulation is “the process of imitating a real phenomenon with a set of mathematical formulas.” Therefore, the input of the simulation process cannot also be the output (result) thereof.

It appears, instead of being “simulated”, each signal segment is “transformed” by the transmission function in z plane. Now, that “transformed” signal segment may be considered as a type of “simulated” signal segment in the z-plane.

Let’s considered the simple sentence, just for illustration purpose, “God creates man” or “Man is created by God”. In the latter sentence, does it mean that man is an input to the creation process? Rather, it appears that man is a result (output) of the creation.

However, if we consider the sentence, again just for illustration purpose, “The computer processes the program” or “the program is processed by the computer”. In the latter case, the program is an input to the computer, not the output (result). The processed program, however, is the result.

In this regard and based on this analysis, it is proposed that the sentence on page 3 (lines 31-32) of the specification being amended to read: “In the next process step 4, each signal segment is transformed into a simulated signal segment by a transmission function in the z plane.” The “signal segment” is being transformed by the transmission function  $H_e(z)$  as defined by equation (1) on page 4 of the specification.

In light of this suggested amendment, the remaining portion of the specification (e.g., page 2) and the claims, if necessary, must also be amended in order to reflect this change and void any other possible problem.

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***Conclusion***

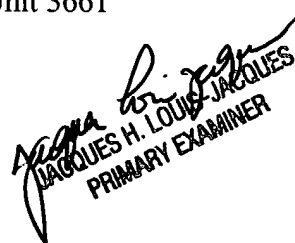
5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jacques H Louis-Jacques whose telephone number is 703-305-9757. The examiner can normally be reached on M-Th 6:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas Black can be reached on 703-305-8233. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Jacques H Louis-Jacques  
Primary Examiner  
Art Unit 3661

/jlj

  
JACQUES H. LOUIS-JACQUES  
PRIMARY EXAMINER